

REMARKS

Claims 1-14 have been examined in the present application. Claims 1-5 and 7-14 have been rejected under 35 U.S.C. § 102(e) over Wang (U.S. Patent No. 6,041,413). Claim 6 has been rejected under 35 U.S.C. § 103(a) over Wang in view of the admitted prior art. Claims 1, 4, 5 and 7 have been rejected under 35 U.S.C. § 103(a) over JP 11143589 in view of JP 11102240. Claims 1, 2, 5, 8, 9, 11 and 13 have been amended hereby. Claim 7 has been canceled hereby. Reconsideration of the present application is respectfully requested in light of the below remarks.

Support for the amendment of claims 1, 5, 8, 9, 11 and 13 can be found in the specification on page 3, lines 2-20.

Claims 1-5 and 7-14 have been rejected under 35 U.S.C. § 102(e) over Wang. Applicant respectfully traverses this rejection.

Independent claims 1, 5, 8, 11 and 13 explicitly recite a “battery-operated computer.” Applicant respectfully submits that this feature of the present invention is neither taught nor suggested by Wang. Withdrawal of the rejection of independent claims 1, 5, 8, 11 and 13 on the basis of Wang is therefore respectfully requested.

As recited in the independent claims, user authentication is performed in the battery-operated computer with the main body operation units kept off by the use of the DC/DC converter. In other words, the main body operation units are turned off by the DC/DC converter when the battery-operated computer is being driven by the battery in a provisional state. Accordingly, the battery-operated computer according to the present invention is driven by the single battery in two different modes, namely, a provisional mode and a normal mode in which the main body operation units are also operated. Such a

provisional state is effective to dispense with special equipment or devices so as to save power, as described on page 3 of the instant specification.

In contrast with the present invention, Wang discloses a computer system power-on security control apparatus which comprises a mainboard (MB) 10, a keyboard (KB) 20, and a power supply unit (PSU) 30. The mainboard 10 includes a keyboard controller 12 and a security control apparatus 40. The security control apparatus 40 monitors the signal communication conducted between the two functional blocks to see if any user, either authorized or not, has depressed on the keyboard 20 with a string of keystrokes that conform to the valid password (column 4, lines 55 to 60). Thus, when the computer is turned off, the security control apparatus 40 still maintains powered on by the power supply unit 30 (column 4, lines 61 to 63).

However, Wang is not concerned with a battery-operated computer nor does he disclose saving power in the battery-operated computer. In this connection, there is no teaching or suggestion in Wang with respect to a relationship between DC/DC converter and main body operation units, such as LCD, CPU, and memory as recited in the independent claims of the present application.

Claims 2-4, 7, 9, 10, 12 and 14 are dependent on and include all of the limitations of their base independent claims as described above. Therefore, all of the above arguments regarding the independent claims are equally applicable to their dependent claims. Withdrawal of the rejection of dependent claims 2-4, 7, 9, 10, 12 and 14 on the basis of Wang is therefore respectfully requested.

Claim 6 was rejected under 35 U.S.C. § 103(a) over Wang in view of the admitted prior art. Applicant respectfully traverses this rejection.

On page 8 of the Office Action, Wang was combined with the admitted prior art in order to cover the “display” and “central processing unit” limitations of claim 6. Applicant respectfully submits that the addition of the admitted prior art to Wang does not cure the deficiencies of Wang discussed above with respect to claim independent claim 5. Claim 6 is dependent on and include all of the limitations of independent claim 5. Therefore, all of the above arguments regarding claim 5 are equally applicable to claim 6. Withdrawal of the rejection of claim 6 under 35 U.S.C. § 103(a) over Wang in view of the admitted prior art is respectfully requested.

Claims 1, 4, 5 and 7 were rejected under 35 U.S.C. § 103(a) over JP 11143589 in view of JP 11102240. Applicant respectfully traverses this rejection.

To properly reject the Applicant’s claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicant. M.P.E.P. §2143. A motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a **reason, suggestion, or motivation in the prior art** that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

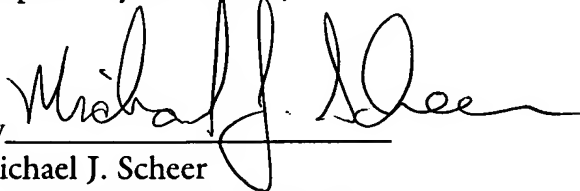
(Emphasis added). Furthermore, The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.

Applicant respectfully submits that the Office Action did not carry its burden to establish a prima facie case of obviousness. The Office action simply stated that claims 1, 4, 5 and 7 were “rejected for the reasons given in the copy of the Japanese Office Action dated 12/14/04 as submitted in the Information Disclosure Statement filed 2/1/05.” Applicant respectfully submits that the Office Action failed to clearly and particularly show reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. Therefore, withdrawal of the rejection of claim 1, 4, 5 and 7 over JP 11143589 in view of JP 11102240 is respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: September 15, 2005

Respectfully submitted,

By 
Michael J. Scheer

Registration No.: 34,425
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
1177 Avenue of the Americas
41st Floor
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

MJS/HM/ll2/rr
Attachments